

Amendments to the Drawings:

Applicants are submitting herewith an annotated set of drawings detailing the requested changes, as well as a replacement set of drawings submitted without markings.

Attachment: Replacement Sheets
Annotated Sheets Showing Changes

REMARKS/ARGUMENTS

Claims 37-45 are pending in the present application. Claims 41 and 44 were canceled; Claims 37, 39, 40, and 43 were amended; and no claims were added.

Support for the amendments is found in the specification, [0046], lines 4-9; Figure 7, 708-718.

Reconsideration of the claims is respectfully requested.

Amendments were made to the drawings to correct errors and to clarify the drawings. No new matter has been added by any of the amendments to the drawings.

I. Drawings

The Examiner has objected to the drawings due to the following reasons:

The drawings are objected to because of mismatching topic names in Figs. 6C and 6D. To be consistent with the rest of the figures showing Topic B as "Project", please change the Topic B name in Figs. 6C and 6D from "Dinner" to "Project".

In response, Applicants have amended the drawings in accordance with the Examiner's suggestions. In addition, in Figure 6D, numeral 530 was changed to 512. No new matter was added.

II. 35 U.S.C. § 103, Obviousness (Claims 37, 40, and 43)

The Examiner has rejected claims 37, 40, and 43 under 35 U.S.C. § 103 as being unpatentable over Brown et al., U.S. Patent Application Publication No. 2003/0023684 (hereinafter "Brown"), in view of Briggs et al., U.S. Patent No. 7,080,139 (hereinafter "Briggs"), and further in view of Bogard, U.S. Patent No. 6,757,365 (hereinafter "Bogard"). Office Action dated August 21, 2009, pp. 4-8. This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of

ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

A. Claim 37

Amended claim 37 recites:

A computer implemented method comprising:
responsive to a first input to a computer by a first user of an instant messaging service adapted for sending and receiving a plurality of text messages in real time between the first user and a second user, determining, by a processor of the computer based only on the first input, that a topic tag is to be inserted into a text message of an instant messaging session, wherein the instant messaging service is adapted to accept the first input before the instant messaging session begins, during the instant messaging session, and after the instant messaging session;
responsive to a second input to the computer by the second user, determining by the processor, one of an acceptance and a rejection of the topic tag by the second user;
responsive to the acceptance, automatically inserting the topic tag, by the processor, into the text of the instant messaging session when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements;
and
responsive to the rejection, continuing the instant messaging session without an insertion of the topic tag.

1. responsive to a first input to a computer by a first user of an instant messaging service adapted for sending and receiving a plurality of text determining, by a processor of the computer based solely on the first input, that a topic tag is to be inserted into a text message of an instant messaging session.

The Examiner states:

paragraph 0069 which further discloses that as messaging server 50 receives messages (i.e. after the second user's response of accepting the first user's selected topic), they are stored according to channel, topic, and sending user and then distributed to each of the receiving users participating in that channel; paragraph 0074 which teaches that multiple windows each associated with a particular topic may be initiated between two users participating in the instant messaging session, wherein a window associated with a particular topic may be left open, but may be indicated as an old conversation, while a new topic window may be designated as a new conversation, and flowchart of Fig. 4 with paragraphs 0075-0077 which disclose that addition of a new topic requires comparing the new topic with current topics open in the current channel, and if the new topic does not match any of the current topics, adding the new topic tag to the channel, thereby disclosing that responsive to a first input to a computer by a first user, determining, by a processor of the computer, that a topic tag is to be inserted into a text message).

The cited art teaches adding a topic based on a comparison of topics. The Examiner cites this portion of Brown to establish the determining step of the claim. Claim 37 has been amended to recite “based solely on the first input.” Therefore, the steps taught by Brown are precluded by the limitation of the claim because Brown cannot determine that a topic tag is to be inserted by a processor using only the first input.

2. responsive to a second input to the computer by the second user, determining by the processor, an acceptance of the topic tag by the second user.

In regard to the element, “determining, by the processor, an acceptance of the topic tag by the second user,” the Examiner states the following:

However, Brown et al. do not specifically disclose responsive to a second input to the computer by the second user, determining by the processor, an acceptance of the topic tag by the second user; and when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements. In the same field of endeavor, Briggs et al. show and disclose the claimed method (and apparatus and computer program product), wherein responsive to a second input to the computer by the second user, determining by the processor, an acceptance of the topic tag by the second user (Fig. 8D that shows a topic sharing interface, with topics/subtopic list 892 and checkboxes 891 that any receiving user may click in to indicate to the processor an acceptable topic, or check it off to

reject the topic previously selected by another user; column 8, lines 42-45 which disclose that each user will be able to turn the displayed topic areas on or off).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine, by the processor, responsive to a second input to the computer by the second user, an acceptance of the topic tag by the second user, as taught by Briggs et al., in the method (and apparatus and computer program product) of Brown et al., so that an instant messaging session with the mutually acceptable topic identified in a new topic window may be started.

Applicants submit that the Examiner incorrectly assumes the purpose of Briggs' Figure 8D. Figure 8D is as follows:

The screenshot shows a web interface titled "Edit fatbubble Profile - friskyriggs". At the top right, there are links for "View" and "Edit". Below this is a navigation bar with four tabs: "Buddy Overview", "Contact Information", "Topic Sharing" (which is selected), and "File Sharing".

Below the tabs, a text block reads: "Use the checkboxes below to select which topic areas you want to share by default. You'll be able to turn these topic areas on or off for each user. [More Info](#)".

The main content area is titled "Topics" and contains a list of topics, each with a checkbox. A label "891" points to the "Select/Deselect All" checkbox, and a label "892" points to the "Arts & Entertainment" checkbox. The topics listed are:

- ☒ Select/Deselect All
- ☒ Arts & Entertainment
- ☒ Computers & Internet
- ☒ Food
- ☒ Games
- ☒ Health & Fitness
- ☒ Home
- ☒ Money
- ☒ Music
- ☒ News
- ☒ People
- ☒ Reference
- ☒ Science & Technology
- ☒ Shopping
- ☒ Sports
- ☒ Travel

Below the list is a link "+ Add Topic Area". At the bottom left, there is a link "Save Changes" with a double colon icon. A label "893" points to the "Save Changes" link.

Figure 8D

Briggs described Figure 8D as follows:

FIG. 8D is a topic sharing interface. Both default and particular user or user group administration is supported. Tick boxes 891 and topic or sub topic names 892 can be used. Additional topics can be added to a list 893. Alternatively, a browser-

style bookmark tree can be used to select topics. Additional fields and links in FIG. 8B have the same placement and usage as in the previous figures.

The Examiner's analysis is as follows: "Fig. 8D that shows a topic sharing interface, with topics/subtopic list 892 and checkboxes 891 that any receiving user may click in to indicate to the processor an acceptable topic, or check it off to reject the topic previously selected by another user; column 8, lines 42-45 which disclose that each user will be able to turn the displayed topic areas on or off." However, Briggs is silent as to the claim limitation. Rather Briggs, as stated in Figure 8D, informs the user to "use the checkboxes below to select which topic areas you want to share by default. You'll be able to turn these topics on or off for each user" (see top half of Figure 8D). Thus, Briggs provides topic sharing, but does not teach or disclose "responsive to a second input to the computer by the second user, determining by the processor, an acceptance of the topic tag by the second user" because the claim limitation requires an acceptance of the topic tag inserted into the text in response to the first input. Therefore, Briggs does not disclose a method for accepting a topic tag inserted into the text in response to the first input.

Furthermore, claim 37 allows the second user to indicate whether he or she wants to classify the IM session under a particular topic indicated by the topic tag and the second user's acceptance of the topic tag. In contrast, the purpose of Briggs' figure 8D topic list is to define which buddies or groups of buddies will have the privilege to read the shared topic text. In other words, Briggs' topic list is used as an administrative interface as described in column 8, lines 42-45. The interface is similar to a file sharing system where a first user determines to which files a second user will have access. Briggs defines a system where a first user uses the interface of figure 8D to determine which other users will have access rights to topic data as explained in Briggs, column 18 lines 19-37, set forth below.

Buddies or groups of buddies are given defined rights to access tracking data collected from the user. Defined rights of buddies to access tracking data may be based on content categories of material accessed. Examples of content categories or topics can be found in FIG. 8D. Defined rights of buddies also could be based on keywords. Definition of rights to access tracking data collected from the user may have multiple aspects. Access may be restricted by the type of activity involved, such as viewing, listening, rating, commenting, assigning an emoticon, sending, watching, downloading, bookmarking or visiting. Access may be further restricted by when the activity potentially accessed took place. It may be

restricted based on a value assigned to a rating or emoticon. It can also be restricted based on its original source. Activities marked private, instead of public, may never be shared, based on a user's decision to turn sharing off. There are many useful combinations of these approaches to define the rights of buddies or groups of buddies to access tracking data.

In contrast, amended claim 37 requires that the IM conversation continue whether the determination is one of acceptance or rejection. The only difference is whether a topic tag has been inserted into the text.

3. responsive to the acceptance, automatically inserting the topic tag, by the processor, into the text of the instant messaging session when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements.

The Examiner admits that neither Brown nor Briggs disclose identifying a turn by a processor. However, the Examiner cites Bogard as follows:

However, Brown et al., as modified by Briggs et al., do not specifically disclose when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements.

In the same field of endeavor, Bogard shows and discloses the claimed method (and apparatus and computer program product), including when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements (column 10, lines 19-38 which show how an introductory conversation topic about using a particular instant messaging service turns to a registration topic when the customer responds with a "No" to a question from the system), wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements about the registration process).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify a turn by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements, as taught by Bogard, in the method (and apparatus and computer program product) of Brown et al., as modified by Briggs et al., so as to mark different topics of discussion in order to later identify and understand which topics were discussed during the session.

Office Action dated August 21, 2009, pp. 4-8.

Applicants submit that even assuming *arguendo* that Bogard discloses determining when a turn takes place, the combined art of Brown, Briggs and Bogard do not disclose “automatically inserting the topic tag, by the processor, into the text of the instant messaging session when a turn is identified by the processor.” In other words, assuming *arguendo* that Bogard determines when a turn is identified by the processor, the combined art is silent as using that process as a trigger to automatically insert a topic tag into the text of the instant messaging session.

Therefore, the rejection of claim 37 under 35 U.S.C. § 103 has been overcome.

B. Claim 40 and 42

In accordance with the Examiner’s statement of allowable subject matter, Applicants have amended claim 40 to incorporate the limitations of claim 41, and have amended claim 43 to incorporate the limitations of claim 44. Therefore, claims 40 and 42 are in condition for allowance.

III. 35 U.S.C. § 103, Obviousness (Claims 39, 42, and 45)

The Examiner has rejected claims 39, 42, and 45 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Briggs and Bogard and further in view of St. John et al., U.S. Patent Application Publication No. 2006/0004702 (hereinafter “St. John”). Office Action dated August 21, 2009, pp. 8-10.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 37 has been shown to be allowable. Claim 39 depends from claim 37. Claims 40 and 43 are in condition for allowance by incorporation of the allowable subject matter of claims 41 and 44 respectively. Claim 42 depends from claim 40 and claim 45 depends from claim 43.

Therefore, the rejection of claims 39, 42, and 45 under 35 U.S.C. § 103 has been overcome.

IV. Objection to Claims (Claim 39)

The Examiner has stated that claim 39 was objected to due to the following informalities:

Claim 39 preamble refers to "The computer-implemented process of claim 37", wherein claim 37 states "a computer-implemented method". The examiner has interpreted "process" as a "method" claim.

In response, the claim has been rewritten to overcome this objection.

V. Allowable Matter

The Examiner stated that claims 38, 41, and 44 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, claims 40 and 43 have been rewritten to incorporate the allowable subject matter of claims 41 and 44.

VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,
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